

## REMARKS

In the Official Action of September 26, 2005, the drawings were objected to, claims 1-5 were provisionally rejected on double patenting grounds over claims 1-4 of co-pending application No. 10/709,442, claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Patent No. 5,668,538, and claims 2-5 were rejected under 35 U.S.C. 103 as being obvious over Patent No. 5,668,538 in view of Patent No. 5,608,655. Applicants respectfully traverse these rejections, and in accordance with the requirements of 37 C.F.R. §§1.111(b) and 1.119, submit the following comments to distinctly and specifically point out the inappropriate nature of these rejections.

First with respect to the drawings, and in accordance with the procedures set out in 37 C.F.R. 1.121(d), Applicant attaches copies of page 1 of the drawings, on which Figs. 1 and 2 appear, and page 3 of the drawings, on which Fig. 4 appears, showing certain proposed changes (in red ink) for approval by the Examiner. The first proposed change appears on Fig. 2, which is labeled as "prior art." A review of the specification of the captioned application indicates that Fig. 2 is described as including components of the present invention. Because it shows components of the present invention, the words indicating that Fig. 2 is prior art have been struck through on the enclosed copy of page 1 of the drawings. In specific response to the objection to the drawings, the enclosed copy of page 3 of the drawings, on which Fig. 4 appears, is proposed to be amended by adding the word "paging" to the box near the top of the page that is labeled "transmitter." This proposed amendment to Fig. 3 does not add new matter since, as described on page 4, line 31 – page 5, line 5 of the specification, a paging transmitter is clearly described such that this proposed amendment to Fig. 3 simply conforms Fig. 3 to the disclosure in the specification. 37 C.F.R. 1.121(e). Approval of these proposed amendments to Figs. 2 and 4 is respectfully requested.

In response to the provisional double patenting rejection over co-pending application Serial No. 10/709,442, an Office Action was mailed in Serial No. 10/709,442 concurrently with the September 26, 2005 Office Action in the captioned application and to which this paper responds. Applicant has not filed a response to the September 26, 2005 Office Action in Serial No. 10/709,442 such that this provisional double patenting rejection will be rendered moot when Serial no. 10/709,442 is deemed abandoned for lack of response. In accordance with the provisions of MPEP 2001.06(b), however, Applicant draws attention to co-pending application Serial No. 09/672,162, filed September 27, 2000.

The §102 rejection over Patent No. 5,668,538, Warwick, is respectfully traversed because Warwick does not disclose all the components of the invention as claimed. Amended claim 1 recites that the processor switches a circuit to interrupt electrical transmission between the supply and the output electrical circuit in response to a signals from a processor that receives wireless radio frequency signals. Warwick does not disclose such structure, and reconsideration and withdrawal of the §102 rejection of claim 1 over Warwick is requested in light of this amendment to claim 1 and the absence of any such disclosure in Warwick.

Turning now to the §103 rejection over the combination of Patent No. 5,668,538, Warwick, and Patent No. 5,608,655, Moughanni, it is respectfully submitted that the Action fails to establish a *prima facie* showing of the obviousness of the differences between the claimed invention and the combination of the Warwick and Moughanni patents. As stated in the second paragraph of MPEP §706.02(j), “[t]o establish a *prima facie* case of obviousness, three criteria must be met.” First, the rejection must indicate some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be some expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPEP §706.02(j).

The lack of a *prima facie* showing of the obviousness of the differences between claims 2-5 and the cited prior art references is apparent by reference to the recitation in the last paragraph of claim 1 of “a processor . . . to open said switching circuit to interrupt electrical power transmission.” Neither of Warwick or Moughanni disclose a switching circuit that interrupts electrical power transmission in response to signals output from a processor. Consequently, it is clear that the cited references do not disclose, alone or in combination, all of the elements of the claimed invention. As required by MPEP §706.02(j), a showing that all the elements of the claimed invention are disclosed in the cited prior art must be made to establish a proper *prima facie* obviousness rejection, and in the absence of such a showing, a §103 rejection is improper and should be withdrawn.

Having established that the cited art does not teach all the elements of the claimed invention as required by MPEP §706.02(j), the next inquiry is whether either reference provides a suggestion or motivation to modify the combined references in the manner claimed. The only suggestion that Applicant can find in the September 26, 2005 Action for making this combination are the allegations set out in the top paragraph of page 6 of the Action to the effect that Moughanni is “in the same field of endeavor [as Warwick] (remote control systems)” and

“[o]bviously, these features [allegedly described in Moughanni] are beneficial in the system of Warwick since Warwick is concerned with controlling electricity meters remotely.” Applicant respectfully traverses the assertion that Warwick and Moughanni are in the same field of endeavor (contrary to the allegation set out in the Action, because Moughanni describes a data processor for a pager, they do not both relate to “remote control systems”), but more importantly, the word “beneficial” is set out in bold type in these quotations from the Office Action to highlight the “generic” nature of this apparent attempt to set out a motivation for combining Warwick and Moughanni. If this kind of generic motivation constitutes sufficient motivation to make the claimed invention, it is not hard to imagine that the §103 rejection in the next application would allege that a remote control system that propels a space ship through outer space at speeds fast enough to make travel between solar systems possible is unpatentable because it is well known that it would be “beneficial” to travel at such speeds. That a goal might be “beneficial” is not a **specific** motivation, disclosed in the prior art, for making the specific combination of prior art references asserted in the Action. In the absence of a specific suggestion to modify the cited references, Applicant calls upon the Examiner to make evidence of record (for instance, in the form of an affidavit as required by MPEP §2144.03) that such a modification and/or motivation is within the Examiner’s personal experience. As stated in *In re Dembiczak* (175 F.3d 994, 1000 (Fed. Cir. 1999), the presence or absence of a motivation to combine references is a question of fact, and Applicant is now calling for submission of such facts.

Although it is listed as not being citable as precedent, the circumstances of the present application appear to be so similar to those at issue in the decision in *In re Beasley* (Fed. Cir. No. 04-1225, December 7, 2004) that the Federal Circuit’s opinion in that case is instructive in the present application. In that decision, the Court stated

“The record reflects that the [E]xaminer and the Board have managed to find motivation for substituting one type of memory for another without providing a citation of any relevant, identifiable source of information justifying such substitution. The statements made by the Examiner, upon which the Board relied, amount to no more than **conclusory statements of generalized advantages** and convenient assumptions about skilled artisans. At least under the MPEP then in effect, such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on ‘subjective belief and unknown authority.’ [*In re*] *Lee*, 277 F.3d [1388] at 1344 (Fed. Cir. 2002). Under such circumstances, with respect to core factual findings, “the Board must point to some concrete evidence in the record of support” of them, rather than relying on its assessment of what is ‘well recognized’ or what a skilled artisan would be ‘well aware.’ *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). ‘To hold otherwise would render the

process of appellate review for substantial evidence on the record a meaningless exercise.’ *Id.* at 1386 [additional citation omitted, emphasis added].”

In the absence of specific evidence as to a motivation to make the claimed combination, and just as in *In re Beasley*, it is clear that the Action fails to establish this second required element of a proper *prima facie* obviousness rejection.

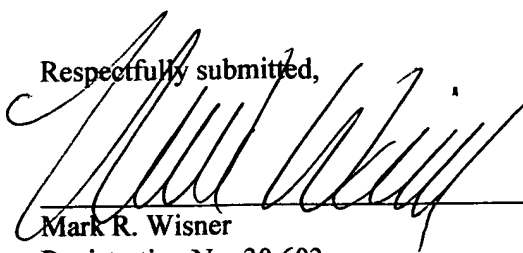
Not only does the Official Action of September 26, 2005 fail to establish this second required element of a proper *prima facie* showing of obviousness, but it is respectfully submitted that it is not possible to make such a showing. It would not be possible to “plug” the system disclosed in Moughanni into the device disclosed in Warwick and expect the resulting combination to function for the intended purpose because, as noted above, neither reference discloses a processor for outputting signals for switching an electrical supply source. It is therefore submitted that it is not possible to find the requisite motivation or suggestion to combine Warwick and Moughanni in the manner asserted in the Official Action.

Of course when there is no suggestion in the art to modify the references in the manner asserted, there can be no showing of the third element of a *prima facie* obviousness rejection, namely, an expectation of success. Further, Applicant is unable to find any indication anywhere in the Official Action of September 26, 2005 that an attempt was even made to establish the required showing of an expectation of success. The above-quoted conclusory allegation from the top paragraph of pages 8 of the Action that Warwick and Moughanni “are in the same field of endeavor” certainly does not provide any indication that the two references can be combined successfully.

In summary, the Official Action of September 26, 2005 fails to establish even one of the elements required to make out a proper *prima facie* showing of the obviousness of the differences between the invention claimed in claims 2-5 and the combination of the Warwick and Moughanni patents. In the absence of a showing of (1) all the claimed elements in the cited art, (2) a suggestion in the art to modify the combined references in the manner claimed, and (3) some expectation that such modification(s) can be made successfully, the §103 rejection of claims 2-5 is improper and should be withdrawn.

Entry of the above amendments to the claims and new claim 6, consideration of the remarks set out herein, allowance of the claims, and passage of the application to issuance are all respectfully requested. In the unforeseen event that there are questions and/or issues yet to be answered in this application, it is respectfully requested that Applicant’s Attorney be contacted at the address and phone number set out below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark R. Wisner', written over a horizontal line.

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